

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Inventorship John H. Zybura
Applicant Microsoft Corporation
Group Art Unit 2166
Examiner Srirama T Channavajjala
Attorney's Docket No. MS305709.01
Title: Incremental Non-chronological Synchronization of Namespaces

REPLY BRIEF

To: Commissioner for Patents
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Pursuant to 37 C.F.R. § 41.41, Appellant hereby submits a reply brief in application No. 10/669,866, within the requisite time of the Examiner's Answer.

REMARKS

Appellant maintains the positions set forth in the Appeal Brief, and respectfully submits that pending claims 1-33 are allowable.

§ 101 Rejections

In the Examiner's Answer, the Office has maintained its rejections of claims 1-33 under 35 U.S.C. § 101. In articulating these rejections, the Office has simply restated the rejections presented in the Final Office Action of October 6, 2006 ("Final Office Action"). Appellant addressed these rejections at length in Appellant's Appeal Brief and in the interest of brevity, will not restate Appellant's arguments herein. As such, Appellant maintains the arguments presented in the Appeal Brief and submits that claims 1-33 comply with the requirements of § 101. Appellant respectfully requests that the § 101 rejections of these claims be overturned.

Double Patenting Rejections

The Office has maintained its provisional rejections of claims 1, 13, 21, 24 and 25 under the doctrine of obviousness-type double patenting over claims 1, 13, 22 and 26 of co-pending Application Serial No. 10/671,408. As stated in the Appeal Brief, Appellant respectfully requests that these provisional rejections be held in abeyance until the notice of allowable subject matter.

§ 103 Rejections

Appellant's Appeal Brief was filed prior to the Supreme Court's recent ruling in KSR International Co. v. Teleflex, Inc., No. 04-1350 (April 30, 2007). In KSR, the Court

addressed the § 103 standard in detail, explaining that “rejections based on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Slip Op. at 14, quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006). The Court further emphasized that “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” Slip Op. at 17, citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 36 (1966). While Appellant’s Appeal Brief was drafted and filed prior to KSR, the findings in KSR simply reinforce Appellant’s position.

First, the Office has failed to show that the cited references disclose or suggest all of the features recited in Appellant’s claims. Second, even if the cited references did show all of the features recited in Appellant’s claims (which they do not), the Office has failed to provide “articulated reasoning with some rational underpinning” to support the cited combination of references. Accordingly, Appellant maintains that the Office has failed to establish a *prima facie* case of obviousness with respect to claims 1-33 of Appellant’s application.

In the Claims

The Office has maintained its rejections of claims 1-15, 20-23 and 25-31 under 35 U.S.C. § 103(a) for allegedly being obvious over U.S. Patent No. 6,061,743 to Thatcher, et al. (“Thatcher”) in view of U.S. Patent Pub. No. 2003/0131104 to Karamanolis, et al. (“Karamanolis”). In articulating the rejections of these claims, the Office has simply restated in the Examiner’s Answer the rejections presented in the Final Office Action.

Appellant addressed these rejections at length in Appellant's Appeal Brief, and in the interest of brevity, will not restate Appellant's arguments herein.

With reference to the discussion of KSR presented above, Appellant submits that the motivation provided by the Office for combining Karamanolis with Thatcher lacks the required "rational underpinning". As discussed in Appellant's Appeal Brief, the motivation provided by the Office is deficient in that it attempts to incorporate features from Karamanolis into Thatcher to perform tasks that Thatcher has already provided for, thus obviating any motivation of a person of ordinary skill in the art to combine the references. (See, e.g., KSR, Slip Op. at 15, stating that "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.") Further, any attempt to add these features to Thatcher would in fact "increase communications overhead by adding an extraneous feature that adds no apparent benefit to Thatcher...." Appeal Brief at page 21. This is contrary to the Office's assertion that combining these references would "bring[] the advantages of 'reduce[d] communications overhead, reduce[d] synchronous I/O and increase[d] operations concurrency....'" Final Office Action at page 16.

With respect to independent claim 21, the Office further argues in the "Response to Arguments" section of the Examiner's Answer that Thatcher suggests the feature of "creating a temporary entity with the second namespace that allows the synchronization to proceed without interference by the conflict", as recited in the claim. The Office cites to Thatcher generally at column 7, lines 4-17. This section of Thatcher discusses rescheduling the update of "replicas" and "obituaries" that keep track of information

pending transmission to other servers. Nowhere, however, does Thatcher discuss the above-mentioned feature.

Accordingly, and in addition to the discussion above, Appellant maintains the arguments presented in the Appeal Brief and submits that the Office has failed to establish a prima facie case of obviousness with respect to claims 1-15, 20-23, and 25-31. Appellant respectfully requests that the § 103 rejections of these claims be overturned.

Additionally, the Office has maintained its rejections of claims 16-19 and 32-33 under 35 U.S.C. § 103(a) for allegedly being obvious over Thatcher in view of Karamanolis and further in view of U.S. Patent No. 6,154,212 to Eick, et al. (“Eick”). In articulating the rejections of these claims, the Office has simply restated in the Examiner’s Answer the rejections presented in the Final Office Action. Appellant addressed these rejections at length in Appellant’s Appeal Brief, and in the interest of brevity, will not restate Appellant’s arguments herein.

Accordingly, Appellant maintains the arguments presented in the Appeal Brief and submits that the Office has failed to establish a prima facie case of obviousness with respect to claims 16-19 and 32-33. Appellant respectfully requests that the § 103 rejections of these claims be overturned.

Additionally, the Office has maintained its rejection of claim 24 under 35 U.S.C. § 103(a) for allegedly being obvious over Thatcher in view of Eick. In rejecting this claim, the Office has simply restated the arguments presented in the Final Office Action. Appellant addressed these arguments in the Appeal Brief and, in the interest of brevity, will not restate the discussion herein. Appellant maintains the arguments presented in the Appeal Brief and submits that the Office has failed to establish a prima facie case of obviousness with respect to claim 24. With reference to the discussion of KSR presented

above, Appellant maintains that the motivation provided by the Office to combine Eick with Thatcher is insufficient to support an obviousness rejection under § 103. One reason that the “rational underpinning” required to support such a rejection is lacking in the Office’s rejection is that Thatcher suffers from no deficiency that requires or would benefit from the addition of Eick. The features of Eick that the Office attempts to incorporate into Thatcher would be simply be superfluous in light of Thatcher’s disclosure. See, e.g., Appeal Brief at pp. 35-36. Accordingly, Appellant respectfully requests that the § 103 rejection of this claim be overturned.

Objections to the Drawings

As noted in the Examiner’s Answer, the Office has withdrawn its previously-stated objections to the drawings.

Conclusion

The Office’s basis and supporting rationale for the rejections discussed above are not supported by the Office’s arguments or the cited references. Appellant respectfully requests that the rejections be overturned and that pending claims 1-33 be allowed to issue.

Respectfully Submitted,

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